

REMARKS

Reconsideration and allowance in view of the forgoing amendment and the following remarks are respectfully requested. Claims 1 and 18 are amended without prejudice or disclaimer.

Rejection of Claims 1, 3, 4, 6 and 18 Under 35 U.S.C. §103(a)

The Office Action rejects claims 1, 3, 4, 6 and 18 under 35 U.S.C. §103(a) as being unpatentable over Cobbley et al. (U.S. Patent No. 5,818,510) (“Cobbley et al.”) in view of Hooks et al. (U.S. Patent No. 6,169,542) (“Hooks et al.”) and further in view of Dimitrova (U.S. Patent No. 6,363,380) (“Dimitrova”). Assignee respectfully traverses this rejection and amends the claims. Assignee notes that none of these claim amendments are made for patentability, but merely to clarify the claim language.

We first turn to claim 1. Claim 1 recites classifying a media collection comprising program content and television commercials as classified program content versus classified television commercials. The Office Action asserts that Cobbley et al. disclose this feature in Figures 1 and 2 in window 210 and column 11, line 5 through column 12, line 12. Assignee again makes a straight forward statement with respect to the “commercial” which is disclosed in window 210 of Figure 2. Window 210 is an index display 210 which “provides multiple subject matter headings 212 of program segments to individual users from the cash index 128.” Column 11, lines 14-16. The subject matter headings 212 include sports and “local news”. The index is shown in an indentation format in which local news stories are indented from the local news subject matter heading. Thus, various stories are identified as local news: city council election results, local resident accidentally shoots himself, cities auto plant considers expansion, commercial-new computer system. Thus, the “commercial-new computer system” is disclosed by Cobbley et al. as a local news story. Column 11, lines 32-37 explain “in one embodiment, the

individual user is able to alter the order in which the news information is presented via an information display area 205 by reordering the selected headings and segments.” Assignee’s basic point is that the Office Action simply assumes that the word “commercial” is a television commercial. This is simply incorrect. The “commercial-new computer system” is a local news story according to the structure of the news and segments of window 210 of Figure 2.

Column 11 identifies these as “program segments”. Nothing in the other disclosure of Cobbley et al. would lead one of skill in the art when reviewing Cobbley et al. to interpret the reference in Figure 2 to a “commercial-new computer system” as a television commercial. Rather, one of skill in the art would recognize it as a program segment or story segment as part of the local news in a news broadcast. Assignee submits that it is inappropriate hindsight that is driving the conclusion in the Office Action that this discloses a television commercial. MPEP 2142 sets forth a *prima facie* case of obviousness and the analysis which must be followed in a Section 103 rejection. The second paragraph under this section of the MPEP states “The tendency to resort to ‘hindsight’ based upon applicant’s disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” In this case, a detailed articulation of why one of skill in the art would not view the “commercial-new computer system” as a local news story that is a program segment is required. This is because the Office Action interpretation cuts against a fair reading of the reference. The scope of this disclosure excludes the local news story about the new computer system as being interpreted as a television commercial.

Therefore, this feature of classifying a media collection comprising program content and television commercials as classified program content verses classified television commercials is not disclosed or suggested by Cobbley et al.

Next, claim 1 recites wherein the television commercials are presented chronologically separate from the program content and in a same display screen as the program content.

Assignee notes that a portion of this limitation which refers to the television commercials being presented in the same display screen as the program content is simply not analyzed in the Office Action. In fact, the Office Action makes clear that this limitation is not disclosed or suggested by Cobbley et al. For example, the Office Action on page 7 states that “Cobbley further display secondary data in window 210, which is separate from the program content display in window 205, where the secondary or associated data, includes sports news, local news,commercial, news, national news, weather, etc.,” (emphasis added). Thus, the Office Action concedes that to the extent it interprets the reference to the local news story about a new computer system as a commercial, that such content is displayed I secondary data window 210 which differs from the content displayed in window 205. Thus, that under the analysis in the Office Action, this particular limitation of television commercials being presented chronologically separate from the program content and in the same display screen as the program content is not disclosed or suggested. (Assignee of course does not acquiesce that the new computer system local news story is a television commercial).

Next, the second full paragraph on page 7 of the Office Action states that “Cobbley does not clearly show that the various secondary data (which includes commercials) are all commercials being presented chronologically separate from program content.” The Office Action asserts that Hooks et al. provides this disclosure. Again, Assignee notes that what is absent from this analysis is any reference showing that the limitation that television commercials are presented on the same display screen as the program content. Therefore, Assignee has identified two limitations within the “classifying” step of claim 1 which are not disclosed by Cobbley et al.

Next, Assignee shall challenge the *prima facie* case of obviousness with respect to the combination of Hooks et al. and Cobbley et al. Indeed, in order to establish a *prima facie* case of obviousness, MPEP 2142 requires that the “supporting a rejection under 35 U.S.C. 103 should be made explicit. The Federal Circuit has stated that ‘rejections on obviousness cannot be sustained with mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.’ Assignee shall explain why one of skill in the art would not likely, by a preponderance of the evidence, combine the disclosure of Hooks et al. with Cobbley et al. The Office Action in response to our previous arguments on page 4 concedes that Cobbley et al. does not show “that the various secondary data (which includes commercials) are all commercials being presented chronologically separate from the program content. Assignee notes that this appears to be a mis-citation of the limitation of claim 1. Specifically, claim 1 requires that “the television commercials are presented chronologically separate from the program content and in the same display screen as the program content.” The Office Action then states on page 4, “However note Hooks reference figures 1-9, discloses a method of storing and delivering ads, where the ads are presented chronologically separate from the program content....Cobbley as modified by Hook, indexes hosted talk shows, show topics, gusts [sic], etc., using various indexing techniques, such as speech recognition, closed captioning,”

Assignee notes that there is no articulated statement or rationale underpinning to support why one of skill in the art would modify Cobbley et al.’s program segments with advertisements. Thus, Assignee challenges the Office Action in this respect. On page 7 of the Office Action, after noting that Hooks discloses ads that are presented chronologically, the Office Action simply concludes that it would have been obvious “to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Hook into the system of Cobbley, to index, search and

present ads in an orderly manner to provide more effective delivery of ad in accordance to preferences of user(s).”

Therefore, to summarize the analysis in the Office Action, it asserts that one of skill in the art would take the story summary in window 210 of Figure 2 and blend into that the disclosure of Hooks et al. in which advertisements are stored and delivered to users. The Office Action asserts that this would provide an effective approach to delivering ads in accordance with the preference of users. Under the KSR analysis, MPEP 2141 requires that “When considering obviousness of a combination of known elements, the operative question is thus ‘whether the improvement is more than the predictable use of prior art elements according to their established functions.’” KSR also notes that then “when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.” Assignee shall explain why one of skill in the art would not likely combine these references in the manner proposed both because of the nature of the subject matter and because it would not be a predictable use for the disclosure of Hooks et al. to be incorporated into Cobbley et al. Specifically, one of skill in the art would not likely add to Cobbley et al., which is limited in its disclosure to news program segments, the additional complexity of presenting advertisements to the user. In other words, it is more likely that users would want to avoid advertisements in the structure of Cobbley et al. and delivering “ads in accordance to preferences of user(s)” would result in a less desirable system according to Cobbley et al. Assignee notes that the basic structure of Cobbley et al. is to receive a stream of broadcast information with video and audio information segments that is transferred to a receiving device. The segments are stored in the cache and indexing information associated with the segments is made available to the end users of the apparatus. This indexing information is shown in Figure 2 in the story summary section 210, which does not include television

commercials but rather sports, local news, national news and weather. The end users are able to select which segments they would like to receive and the selected segments are transmitted to the requesting user. Cobbley et al. also disclose “when a new segment is received, a determination is made as to whether it is a more recent version of another segment already stored by the apparatus. If it is a more recent version, then the older version is overwritten by the newer version.” See column 2, lines 8-22. Column 8, line 35, explains that the broadcast information transmitted by broadcast source 105 “is a repeating news broadcast. For example, the broadcast 10 information may be Turner Broadcasting’s CNN Headline news, which repeats four program segments every thirty minutes...Due to the repeating nature of such news broadcasts, it is not necessary for cache 130 to store the entire day’s broadcasts. Thus, cache manager 125 removes the video and audio data stored in cache 130 for broadcasts earlier in the day.” The approach of Cobbley et al. provides the user with the ability to select “those [segments] that he or she wishes to view. This may be done on a segment-by-segment basis, or may be all the story segments within a particular subject area.” Column 9, lines 59-62.

Assignee submits that the error in the Office Action analysis is that one of skill in the art would likely insert into Cobbley et al. the delivery of ads according to the preferences of users. Because the purpose of Cobbley et al. is to index program segments and news, and to update news segments throughout the day if a more recent version exists, the preponderance of the evidence is against a user actively having a preference to view advertisements under the system of Cobbley et al. Assignee submits that this is essentially a matter of common sense that if a viewer is given the opportunity via the system of Cobbley et al. to avoid commercials and control the manner in which they view program segments according to Figure 2, one of skill in the art would not likely insert an additional mechanism relating to the delivery of advertisements. Users would likely avoid such a system. Under a KSR analysis, which relates to the predictable

use of prior art elements, cuts against the analysis in the Office Action. This is because it would not be a predictable use of the disclosure of Cobbley et al. to add a feature of presenting advertisements to the user. Indeed, the Wikipedia article on television advertisement helps to make Assignee's point. This article states:

“despite the popularity of some advertisements, many consider them to be an annoyance for a number of reasons. The main reason may be that the sound volume of advertisements tends to be higher...then that of regular programming. The increasing number of advertisements, as well as overplaying of the same advertisement, are secondary annoyance factors. A third might be that television is currently the main vision medium to advertisement, prompting ad campaigns by everyone from cell phone companies, political campaigns, fast-food restaurants, to local businesses and small businesses, prompting longer commercial breaks. Finally, another reason is that advertisements often cut into certain parts of the regular programming that are either climaxes of the plot or a major turning point in the show, which many people find exciting or entertaining to watch.” (emphasis added)

Next, this article explains that “from a cognitive standpoint, the core reason people find advertisements annoying is that the advertisements offer is not of interest at that moment, or their presentation is unclear. A typical viewer has seen enough advertisements to anticipate that most advertisements will be bothersome, prompting the viewer to be more selective in their viewing.” (emphasis added) Assignee submits that this common sense view would indicate that if a user has the type of control over the programming that is made available by Cobbley et al. in which an indexed display 210 of Figure 2 provides the ability to the individual user to control specifically what program segment they will be able to watch, that it would be unlikely that the average user would want to add advertising information. As a practical matter, why would a user, which have been essentially proven to find advertisements generally annoying, want to have indexed advertisements presented to them in a summary that they would then for some reason choose to watch? The answer is clearly that given the choice users would not view advertisements but only view the program segments they desire. Therefore, it is clear that as a practical matter the analysis on page 7 of the Office Action with respect to combining the Hooks

et al. advertisement storage and delivery approach into the teachings of Cobbley et al. is unpersuasive. Users simply would not ever or rarely actually manage how advertisements are presented to them according to their preference. Because users generally find advertisements annoying, one of skill in the art would not likely develop a system in which the users could both control the program content which they view as well as taking the time, energy and cost of building in a user preference and management system for enabling the users to choose what ads they would view. Of course, the ultimate reason is that the users would simply choose to not view any advertisements but rather only view the content that they desire. Therefore, Assignee has provided substantive reasons why one of skill in the art would not likely modify Cobbley et al. by Hooks et al.

The MPEP 2141.01, Section V, requires that the Office personnel should reconsider all rebuttal evidence. Once Assignee has presented rebuttal evidence, the Office personnel should reconsider any initial obviousness determination in view of the entire record. Rejections of record and their basis should be reviewed to confirm their continued viability. Assignee submits that we have presented convincing evidence that one of skill in the art would not likely amend or modify the teachings of Cobbley et al. in order to index, search and present advertisements through their user interface of Figure 2. Therefore, claim 1 is patentable and in condition for allowance.

In sum, Assignee has presented several limitations of claim 1 which are not disclosed or suggested in the art, one of which (television commercials being presented chronologically separate from the program content and in the same display screen as the program content) is not even addressed in the Office Action. Next, Assignee has provided rebuttal evidence showing that one of skill in the art would not likely by a preponderance of the evidence modify Cobbley et al. with the teachings of Hooks et al. Accordingly, claim 1 is patentable and in condition for

allowance. Additionally, claims 3-4 and 6 depend from claim 1 and recite further limitations therefrom. Accordingly, these claims are patentable and in condition for allowance as well.

Claim 18 is also patentable for the same reasons set forth above relative to claim 1.

Rejection of Claims 5 and 7 Under 35 U.S.C. §103(a)

The Office Action rejects claims 5 and 7 under 35 U.S.C. §103(a) as being unpatentable over Cobbley et al. in view of Hooks et al. and further in view of Dimitrova and further in view of Hoffert et al. (U.S. Patent No. 5,983,176) (“Hoffert et al.”). Claims 5 and 7 each depend from claim 1 and recite further limitations therefrom. Accordingly, Assignee submits that these claims are patentable and in condition for allowance. Assignee also does not acquiesce that it would be obvious to one of skill in the art to combine any of the other references in the manner proposed in the Office Action. However, since Assignee has presented numerous reasons why the independent claims are patentable and in condition for allowance, Assignee reserves the right to argue against any such combination in later prosecution.

CONCLUSION

Having addressed all rejections and objections, the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Novak, Druce & Quigg, LLP, Account No. 14-1437** for any deficiency or overpayment.

Respectfully submitted,

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